

REMARKS

Claims 1-37, 47, 64-70 and 88-92 are active in this application.

Claims 1, 2 and 25 have been amended to incorporate the limitations of previously presented Claim 63, which has now been cancelled.

Claim 92 finds support on page 21, last paragraph.

No new matter is added.

In view of the finality of the Restriction Requirement, claims directed Group I have been retained while the non-elected and withdrawn claims cancelled.

The Examiner has rejected the claims under §102(b) based on three different documents, i.e., Kitajima (U.S. Patent No. 3,691,090), Leinen (U.S. Patent No. 4,520,142), and Schobel (U.S. Patent No. 4,824,681). The issue that underlies each of these three rejections is the same, i.e., each allegedly teaches encapsulated products but describe or suggest nothing with the respect to the tensile strength of that encapsulated products. Nonetheless, the Examiner has taken the position that tensile strength would be inherent. Applicants disagree and explain below why none of Kitajima, Leinen, and Schobel disclose compositions as required under the law of inherency.

The Examiner has noted that Kitajima, Leinen, and Schobel “inherently” achieve the tensile strengths defined in the claims. However, the Examiner has provided no proof of this. Rather, the Examiner is using Applicants’ disclosure against them. As noted by the court in *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323 (CCPA 1981), the mere fact that a certain thing may result from a given set of circumstances is not sufficient to prove inherency. Inherency may not be established by probabilities or possibilities. Something that is inherent must inevitably be the result each and every time.

It is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984), quoting *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967).

As noted by the Board of Patent Appeals and Interferences in *Ex parte Skinner*, 2 USPQ2d 1788, before an Examiner can switch the burden of proof of showing non-inherency to the applicant, the Examiner must provide some evidence or scientific reasoning to establish the reasonableness of the Examiner's belief that the limitation in question is an inherent characteristic of the prior art. In this case, the Examiner has provided no such evidence.

It is Applicants' position that none of Kitajima, Leinen, and Schobel describe compositions that each and every time will have the tensile strength defined in the claims. In the way of background it should be appreciated that the tensile strength of a composition will depend on the composition itself, the morphology of the solid material distributed in the composition and solvent residue. Indeed, even minor amounts of solvent, e.g., about 0.5%, have a dramatic lowering effect on the tensile strength of the encapsulation. As explained in more detail below, the methodology employed by Kitajima, Leinen, and Schobel utilize solvents and as a result would generally result in tensile strengths much lower than that which is claimed and therefore none of Kitajima, Leinen, and Schobel describe compositions which inevitably result each and every time with compositions having the tensile strength defined in the claims.

Kitajima describes a process for the preparation of capsules containing a core material, where the core material is dispersed in a solution of an organic solvent and an encapsulating material. (see col. 1, lines 40-45). The suspension (core material and encapsulating material/solvent) is then dispersed in an aqueous salt solution and then the organic solvent is removed. This Kitajima process will result in capsules with core shell type

morphology and no matter how hard one tries the solvent residue will always be present in the final capsules. Because of the core shell morphology and solvent residue, the capsules will not, each and every time, have the minimum tensile strength as claimed.

Withdrawal of the rejection based on Kitajima is requested.

Leinen describes an encapsulation material comprising a liquid core and a polymeric shell material (see col. 1, line 65 to col. 2, line 6). The liquid core can be fragrances encapsulated by shell material such as polyvinylpyrrolidone, and polyacetates among others (see col. 2, lines 39-49). The capsules are prepared using a solvent (see, e.g., Examples 1-13 in col. 6). A liquid core surrounded by a polymeric shell with residual solvent from the encapsulation process will not, each and every time, have the minimum tensile strength as claimed.

Indeed, Leinen teaches one away from making capsules with the tensile strength defined in the claims. The Leinen capsules are for use of the liquid center capsules in aerosol applications to delay release of actives. Leinen teaches that the active ingredient should release by applying small breaking forces such as fingernails (see col. 2, 20-22). Making capsules with tensile strength greater than 10,000 psi will not break by such small forces as applied by fingernail or rubbing etc.

Withdrawal of the rejection based on Leinen is requested.

Schobel describes an encapsulated sweetener where the coating material comprises a hydrophobic polymer and a hydrophobic plasticizer and the polymer can be polyvinyl acetate phthalate (see col. 3, lines 37-42 and col. 7, lines 14-26). Schobel describes in the paragraph bridging col. 8-9 that the encapsulation is prepared by spray drying, coacervation, or a fluidized bed coating process. Each of these procedures utilizes a solvent to prepare an

encapsulation. Indeed this is what Schobel describes in the Examples found in col. 10-12.

The morphohology and residual solvent in the spray encapsulated material, the coacervation process, and the fluidized bed coating process described by Schobel will not, each and every time, have the minimum tensile strength as claimed.

Withdrawal of the rejection based on Schobel is requested.

The rejection under 35 USC § 101 as claiming the same subject matter as the co-pending application Serial No. 11/083,968 is only a provisional application. As the claims of the copending case have not been allowed, it is requested that this rejection be held in abeyance.

There are also several provisional obviousness-type double patenting rejections in view of co-pending cases. Those co-pending applications are 11/134,356; 11/134,365; 11/134,367; 11/134,370; 11/134,371; 11/134,480; and 11/135,153. Applicants request that these provisional rejections be held in abeyance as the alleged conflicting claims have not yet been patented. Further, Applicants note the following from MPEP § 822.01:

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

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Favorable reconsideration and allowance of all pending claims is requested.

Should the Examiner have any questions or wish to discuss any aspect of this application, he is invited to contact the undersigned.

Respectfully submitted,

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